

REMARKS/ARGUMENTS

Claim Objections

Examiner requires appropriate correction to line 4 of Claims 21-24, where "said solid object" is recited without antecedent basis.

Applicant has corrected the informalities by inserting the phrase "a solid object, having:." directly after the introductory "comprising" in Claims 21, 22, and 24. Previous amendment of Claim 23 deleted the offending phrase in this instance.

Claim Rejections

In view of the following remarks, reconsideration of the outstanding Office Action is respectfully requested.

Please note as United States Patent Application Publication U.S 2004/0032748 is not a pending application, as it was abandoned on August 10, 2004, Applicant is currently filing a Declaration under 37 CFR 1.131 to swear behind the Turdeau *et al.* application. The Declaration is appended in the Appendix.

Please, also note that Applicant tried to contact Examiner to discuss the filing of a Declaration, but Examiner is on leave. Applicant called Examiner's Supervisor and left a message and has, so far, not received a reply. Applicant has also called the Board of Patent Appeals and has not yet been able to make contact with the Board, so Applicant is following the law as Applicant has determined the law, to date.

1. The rejection of **Claims 21 and 22** under 35 U.S.C. 103(a) as being unpatentable over MORI (U.S. Patent No. 4,510,555) in view of TRUDEAU *et al.* (US 2004/0032748) is respectfully traversed and Applicant respectfully submits that considering Examiner has not established a *prima facie* case of anticipation.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP 2131

In regard to amended **Claims 21 and 22** , Claims 21 and 22 currently recite:

Claim 21 (currently amended) A self-illuminating fabricated solid object assembly comprising:

- a solid object, having:
 - a) at least one visually exposed surface;
 - b) at least one aperture, said aperture opening on an accessible surface;
 - c) at least one optical fiber positioned within said solid object;
 - d) a first end of said optical fiber visually terminating at said visually exposed surface of said solid object;
 - e) a second end of said optical fiber operatively related to said aperture to receive light,
 - f) at least one receptacle operatively relating to said at least one aperture, said receptacle receiving said second end of said optical fiber providing for said second end of said optical fiber to receive light,
 - g) said at least one receptacle receiving an exchangeable light source comprising a **light emitting diode** providing for transmission of light from said exchangeable light source to said first end of said optical fiber, wherein said light source additionally comprises at least one fiber optic cable, said cable adapted for the transmission of light from said at least one exchangeable light source.

Claim 22 (currently amended) A self-illuminating fabricated solid object assembly comprising:

- a solid object, having:
 - a) at least one visually exposed surface;
 - b) at least one aperture, said aperture opening on an accessible surface;
 - c) at least one optical fiber positioned within said solid object;
 - d) a first end of said optical fiber visually terminating at said visually exposed surface of said solid object;
 - e) a second end of said optical fiber operatively related to said aperture to receive light,
 - f) at least one receptacle operatively relating to said at least one aperture, said receptacle receiving said second end of said optical fiber providing for said second end of said optical fiber to receive light,
 - g) said at least one receptacle receiving an exchangeable light source comprising a **light emitting diode** providing for transmission of light from said exchangeable light source to said first end of said optical fiber, wherein said light source additionally comprises at least one fiber optic cable, said cable adapted for the transmission of light from said at least one exchangeable light source,
- wherein said at least one fiber optic cable is received by a plurality of solid objects.

Applicant's claims recite a "light emitting diode." Examiner states on Page 3, last line of No. 5, that "However, MORI does not disclose a light emitting diode." Examiner states that TRUDEAU teaches a light source comprising a light emitting diode. Applicant has sworn behind TRUDEAU. Applicant is drafting this reply assuming that his Declaration will remove the TRUDEAU reference, so therefore TRUDEAU is no longer a valid reference.

As it has been established that MORI does not disclose a light emitting diode and TRUDEAU is not a valid reference, it can be concluded that each and every element as set forth in the claim is not found, either expressly or inherently described, in the reference. And, as the identical invention is not shown in as complete detail as is contained in Applicant's claim, Mori does not anticipate Applicant's invention.

In fact Mori, teaches his cable as one that carries light, such as sunlight, that must be condensed by a lens into an optical cable (see Col. 1, lines 9 – 13, Col. 2, lines 12 – 14, and Col. 2, line 40.). Condensing sunlight into a cable is taught as a means to construct ornamental lighting devices free from the generation of heat (Col. 1, lines 12 – 15).

Moreover, Mori's optical fiber's must be parallel to each other, which is not a requirement in Applicant's invention, and they must be spaced apart, which is not a requirement in Applicant's invention.

It follows then that Mori does not either expressly or inherently describe Applicant's invention.

Thus, for these reasons, as provided above, Applicant respectfully submits that **Claims 21 and 22** are patentable over the cited reference.

2. The rejection of **Claim 23** under 35 USC § 103(a) as being unpatentable over MORI in view of TRUDEAU *et al.* (US 2004/0032748) as applied to Claims 21 and 22 above, and further in view of MOUISSIE (U.S. Patent No. 4,845,596) is respectfully traversed and it is respectfully submitted that Examiner did not establish a *prima facie* case of obviousness.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under **35 U.S.C. 103**, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03. Moreover, "Claims in dependent form

shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." MPEP 608.01(i).

In regard to **Claim 23**, Claim 23 currently recites:

Claim 23 (previously amended) The self-illuminating fabricated solid object assembly, as recited in Claim 21, further comprising:
wherein on said at least one visually exposed surface a plurality of predetermined patterns for receiving light comprise informational messages.

It was shown above that Mori in view of Trudeau *et al.* cannot provide a *prima facie* case of thus obviousness as Applicant has sworn behind the Trudeau *et al.* application, and therefore Claim 21 is now in condition for allowance, and as Claim 23 depends from Claim 21, it too is allowable.

Trudeau cannot be used as a reference and neither Mori nor Mouisse teach the use of LED, even in combination they do not teach all of the limitations of Applicant's invention and cannot be used together to reject Applicant's invention.

Moreover, there would be no reason to combine Mori and Mouisse as Mouisse does not teach "wherein on said at least one visually exposed surface a plurality of predetermined patterns for receiving light comprise informational messages" as claimed by Applicant in Claim 23. Mouisse simply teaches that his illumination device can be used not to in themselves create messages but simply as background illumination of flat information display units such as liquid crystal display panels, text panels, instrument panels, etc.

It follows then that Mori in view of Mouisse does not either expressly or inherently describe Applicant's invention and thus, for these reasons, as for the reasons provided above, Applicant respectfully submits that **Claim 23** is patentable over the cited references.

ALLOWABLE SUBJECT MATTER

Claim 24 was previously amended to to include all the limitations of base Claim 21 and is now in condition for allowance.

CONCLUSION

The Prior art made of record and not relied upon was considered.

Applicant believes that all of the claims pending in the Application are now in condition for allowance. Accordingly, favorable consideration of the present application is respectfully requested so that the application may timely pass to issue.

Respectfully submitted,
For Walter E. Pipo, Applicant

/Patricia M. Costanzo/ Electronic Signature
Patricia M. Costanzo
Attorney for Applicant
Reg. No. 48,809

P.O. Box 101
2960 Bowen Road
Elma, NY 14059
Facsimile: 716-652-8868
law@patcostanzo.com

November 22, 2006